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In the Supreme Court of the United States

OCTOBER TERM, 1940.

THE SCHRIBER-SCHROTH COMPANY,
Petitioner,
vs.
THE CLEVELAND TRUST COMPANY,
CHRYSLER CORPORATION,
Respondents.
No. 9.

THE ABERDEEN MOTOR SUPPLY COMPANY,
Petitioner,
vs.
THE CLEVELAND TRUST COMPANY,
CHRYSLER CORPORATION,
Respondents.
No. 10.

THE F. E. ROWE SALES COMPANY,
Petitioner,
vs.
THE CLEVELAND TRUST COMPANY,
CHRYSLER CORPORATION,
Respondents.
No. 11.

PETITION FOR REHEARING.

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PETITION FOR REHEARING.

To the Chief Justice and the Associate Justices of the Supreme Court:

The respondents in the above entitled causes respectfully ask a rehearing of the disposition thereof made by the opinion of the Court filed December 9, 1940, upon the following grounds:

I. The questions which the opinion made determinative were never presented to nor considered by any

court below nor presented to this Court by petition or brief, and respondents have had no opportunity to be heard thereon.

II. The Court erred in its statements and conclusions, in such opinion:

(1) That allowed claim 8 and cancelled claim 19E were equivalent (except for web flexibility).

(2) That allowed claim 8 (with web flexibility) was broader than cancelled claim 19E.

(3) That the invention of the patent was properly summarized in the opinion, though by such summary the Court in effect rewrote the claims in suit.

(4) That an estoppel arises by cancelling a narrow and accepting a broad claim.

(5) That a claim which is offered as and becomes a count in an interference with several applicants can be interpreted except by a construction which makes it applicable to the varying forms of all parties to the interference.

(6) That, by reading into it elements not specified therein, the Court has given to the cancelled claim a narrower construction than it reasonably bears, overlooking that it was proposed by the Patent Office as an interference claim, and that the law requires an interference claim to be given the broadest construction its language will bear, and such a construction that it will rightly comprise all of the various forms in interference (see p. 25, *infra*).

The reasons supporting these suggestions of error will now be stated.

The purpose of this petition is not only to seek a rehearing because of what seems to us erroneous reasoning by which the Court reached its conclusion upon the point thought determinative, but also to bring to the attention of the Court what we believe to be misapprehension of some facts relating to the Patent Office proceedings and to the

mechanics of and operation of the piston,—which latter errors, even if not controlling the result declared by the opinion, the Court will doubtless wish to correct (if correction there should be) to the end that the opinions of this Court may be as nearly as possible impeccable. To this result we believe it is the duty of counsel to contribute, by all pertinent respectful criticism.

Preliminary.

We feel specially justified in asking reconsideration and rehearing of the determinative portion of the opinion because its reasoning depends essentially upon two basic propositions: (1) that the claims cancelled were narrower than those allowed, from which proposition the Court develops the conclusion that the broader allowed claim cannot be construed as equivalent to a narrower cancelled claim, or (2) upon the alternative proposition that (under plaintiffs' construction) the claims allowed become equivalent to the claims cancelled. We respectfully submit that these propositions make their first appearance in this litigation in the present opinion of the Court. They were not presented in the petition or petitioners' briefs or in the oral argument, and we have never had occasion to discuss them. We do not pause now to demonstrate that we are correct in this statement, or to differentiate between these propositions and the proposition which the petitioners did present (belatedly) to the court below and then to this Court; but we make that demonstration, as we believe, in Appendix A, *infra* page 32.

The fact that these questions now arise for the first time is important for vital additional reasons. If in the District Court, by defendants' pleading, or in any way before the record was closed, it had been insisted either that the allowed and cancelled claims were equivalent or that the allowed claim was broader than the cancelled, plaintiff would have shaped the record to reply to these contentions.

There would have been the testimony of experts pointing out how the differences were material and how, practically as well as verbally, the cancelled claims were broader. Perhaps more important than this, the various interference records would have been put in evidence. Each one of the cancelled claims formed the count, or one of the counts of an interference. In some of these interferences there were rulings by the examiner of interferences or by the law examiner or by the appellate tribunals involving the scope and the construction of these cancelled claims and putting upon them the stamp of interpretation by the Patent Office tribunals. Under the familiar holdings of this Court these Patent Office interpretations would have been followed, unless they were very clearly wrong. The burden was upon the defendants in the District Court to allege and to show everything material to any existing defense; the plaintiff cannot be blamed for not making a complete record to overthrow a defense which had not been made at all. Counsel may not ordinarily refer to matters outside the record, but they may say what they believe they would have been able to show in opposition to a belated defense if it had been made while the record was open. We assert therefore that such expert testimony and such Patent Office proceedings would have materially supported and confirmed the argumentative inferences which we make from the present incomplete record. Some of these proceedings are shown in our accompanying motion.

I. Claim Identity and Construction.

It is the familiar fact that if the construction, later contended for by the patentee, of a claim retained and allowed, makes it of the same breadth and scope as the proper construction of an apparently broader claim cancelled and abandoned, the patentee cannot be permitted thus to recapture a definition of his invention which definition

he had once thus disclaimed,[1] but the court will give to the allowed claim a construction which will prevent such recapture. The controlling question therefore is as to the substantial identity of the claim, thus allowed and thus construed, with the claim thus abandoned. For the purpose of this consideration the court selected claim 8 of the Jardine patent (Op. p. 6) and claim [18] 19E of the cancelled and abandoned claims (Op. pp. 6 and 7),[2] and thereupon, in the first full paragraph of page 7 and in the first full paragraph of page 9, points out the reasons convincing the court that the two claims were subsantially identical, except for the "web flexibility."

In elaborating this substantial identity, the court said (p. 9): "* * * the amended and cancelled claim and allowed claims 1, 8 and 11 did not specifically mention retraction of the skirt from the bosses"; and the Court then assumed that this limitation could be read into both the allowed and the cancelled claim by reference to the appropriate specification and drawings. In both this reference to the form of the claims and in this assumption, the Court, we respectfully insist, was wrong.

As to the form of the claims, the fact is that this limitation *is* contained in the allowed claims and *is not* contained in the cancelled claim. The fact also is that this is a structural limitation, of importance as hereafter pointed out, and that in this very litigation this Court has affirmed and applied the rule that a limitation cannot be read into a claim. In thus reading this limitation into the cancelled claim the Court violates its own rule.

A reference to the record shows that in claim 1 this "retraction of the skirt from the bosses" *is* specifically

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[1] Unless perhaps the effect of the cancellation may have been neutralized in the further progress of the application.

[2] It seems unnecessary to consider also separately the other claims sued upon, 1 and 11. Analogous comparisons would result.

mentioned by the equivalent language "a skirt integral with the said webs relieved adjacent said webs." In claim 8, it *is* specifically mentioned, by the equivalent language "a skirt integral with the said webs and cut away to expose the sides of said webs." In claim 11, it *is* specifically mentioned and expressed by the equivalent words "a skirt joined to the ends of the webs on opposite sides of the bosses and cut away to expose substantially all of the sides of the webs."

The drawings and specification of Jardine (R. p. 541) clearly show that the skirt, instead of being continuous and unbroken over the region of the bosses, is cut away or non-existent in this region, and thereby thermal expansion of the bosses upon their axial line, which might come out against the skirt and force the skirt against the cylinder, with disastrous results, if the skirt were there, is yet permitted to expand freely and without harm out to the very cylinder wall. This essential feature of the Jardine construction is described in the Jardine specification. (R. 541, ll. 65-70, *et seq.*). The skirt segments are located on either side of the bosses thereby declaring that they do not extend over the bosses. The specification does not use the word "relief"; but that was a name therefor familiar in the art to describe any degree of skirt retraction which might be appropriate to a particular construction. The word was proposed to the Patent Office in claim 1 as the appropriate word for this skirt retraction, and it was accepted by the Patent Office as properly defining this feature of skirt retraction. Its propriety for that purpose has never been challenged.

The phrase "cut away to expose the sides of said webs" in claim 8 is also not found verbatim in the specification, but is likewise perfectly appropriate to describe a skirt which does not extend over the bosses, and with that meaning the phrase was proposed to the Patent Office as a part of the definition of the invention and was accepted.

That it is properly descriptive of this feature has never been denied.

In claim 11 the phrase "cut away to expose substantially all of the sides of the webs" is of the same effect as the corresponding phrase in claim 8, save that, as to this feature, it is narrower in that it requires a somewhat greater degree of cutting away.[3] As the defendants have well said, claim 1 called for relief, claim 8 for greater relief, and claim 11 for extreme relief.

Jardine regarded this skirt retraction, or cutting away, or relief, as an essential feature of his invention, for he included it expressly or by equivalent words in eleven of his twelve claims in the issued patent. He had included it in several of his original claims (R. pp. 756, 757) by the equivalent language which specified that the pin bosses were opposite the unoccupied skirt space which was between the two non-continuous parts of the skirt. He never abandoned this feature, for it continued to be present in nearly all of his claims presented up until he accepted the amended claims to which the Court refers, and which were made by copying claims of other applicants pursuant to the suggestion of the Patent Office. In all of his amended claims which referred to flexibility (R. pp. 788-790), he did *not* include

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[3] There is some confusion between retraction of the bosses from the skirt and retraction of the skirt from the bosses. These are two very different things. They may or may not coexist. The element or limitation "retraction of the bosses from the skirt" was a radial retraction and was a feature of the Gulick patent and of the claims in suit upon that patent and was used by the court below in describing what was then believed to be the invention of the Gulick patent. The Gulick construction (R. p. 528, Figs. 3 and 4) shows that the bosses might move outward slightly but would then come against the overlying skirt, with whatever evils might result from that almost immediate expansive contact. Gulick provided only a hole in the skirt "so that the piston pin may be inserted" (lines No. 100, p. 1 and 1 p. 2 of patent; R. pp. 530, 531). Jardine, on the contrary, retracted or discontinued the skirt circumferentially in the region of the bosses, so as to avoid completely any skirt interference with the desirable axial expansion of the bosses.

this feature, directly or by inference, thereby making the amended claims in this respect broader than the original or the issued claims; and he *necessarily* thus omitted this feature because these claims were by the interference declarations made of such broad scope that they applied to the forms of Hartog, (Spillman and Long),[4] whose respective devices *did not contain* this feature.

This construction, under the name of "relief," was a feature of the Maynard patent and of the infringing device Exhibit 1 made by the Sterling Company. Indeed, the briefs on both sides in the first *certiorari* assumed or claimed that the piston could not be commercially operative without this relief. Long's pistons without this relief were not satisfactory. So too the Sterling Company, after unsuccessful efforts, was compelled to embody in Exhibit 1 this feature, "relief," before it could make a successful piston; and that because its relief was of keystone shape instead of rectangular, it did not infringe, was the burden of defendants' brief.

To reach its conclusion this Court now must consider immaterial this distinction between allowed claim 8 and cancelled claim 19E, whereby one claim was limited by this call and the other was not. It was not so considered by the Patent Office, or by the various contesting applicants, or by the industry. The contention of such immateriality was not made before the Master or the District Court or the Court of Appeals on the first or second hearing or by the petitioners' brief here, and is not supported by any evidence in the record. The distinction pertains to unseen and unseeable operation, involving tremendous forces and incomprehensible speed, where a variation of 1/1000th of an inch determines success or failure. We most respectfully, but most earnestly, submit that on such a point

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[4] The Spillman and Long applications defendant did not put into the record. We are showing them in our accompanying motion. Therefore we hereafter refer to them in parentheses.

no court possesses the judicial knowledge enabling it to speak *ex cathedra*.

It is of special interest to note that the amended claim which the Court has selected [18] 19E was one of those proposed by the Patent Office to Jardine as one of the issues in the expected interference, which included Hartog, (Long and Spillman, whose interfering applications did not result in patents of record here); but this claim or issue was thus declared to be appropriate to and proper to read upon these other three forms. The record does not show from which original application it was copied or whether it was formulated *ex parte* by the office, but it cannot now be given by the Court any construction which would leave it inapplicable also to each one of these four. Upon the present record[5] we can compare only with Hartog; but even that will be sufficient.

It is further interesting to note that this 19E was the claim which, with claim 22E, became the two counts of Interference No. 49578, and that the Patent Office thus declared that the two counts or claims were distinct from each other, indicating different structures, and each independently calling for its own separate date of conception and reduction to practice and each supportable by distinct proofs. In observing the distinctions between amended claims 19E and 22E, which thus (like all the other cancelled claims) were declared to be distinct inventions, the Court will see that 19E is relatively limited in several particulars while claim 22E is very broad, calling only for any kind of "means" for the yielding connection, and the Court will notice that one of the distinctions is that 19E calls for "skirt carriers * * * susceptible of being slightly flexed radially." This was language appropriate to Hartog (and probably to Long and Spillman), in which the skirt carriers were integral extensions in the continuous curve of the

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[5] And without reference to our motion.

skirt and in which the flexing of these bow-like carriers was exactly radial when pressure was exerted upon the cold skirt to compress it and insert it into the cold cylinder; while this language is not applicable at all to the Jardine allowed claim 8, as plaintiff thinks it should be now interpreted, because the flexing of Jardine's webs is not radial of the skirt and cylinder but is rather circumferential, or possibly tangential,—or if the flexing takes effect longitudinally of the web, then its direction is chordal of the skirt. The Court cannot say that this difference is immaterial. A radial compression might make the combination successful or unsuccessful; a tangential yielding, as upon a hinge, or the cantilever principle, might make the combination successful or unsuccessful. The Court cannot judicially know, and the record does not tell us, except as the Jardine form was successful and the Hartog form, so far as the record shows, was neither used nor feasible.

Certainly it has never been thought that when a claim was rejected because, in its greatly extended and broad meaning, a contestant was the prior inventor, the applicant's acquiescence in that rejection has any effect upon the construction which should be given to his allowed claims which are confined to specific features which his specification and drawings *did* show, but which the contestant did not have.

Coming back to the same paragraph on page 9, the Court further finds identity between claim 8 (if the webs be flexible) and cancelled claim [18] 19E, because the latter embraces[6] "flexing webs supporting 'retracted bosses.'" The cancelled claim does not specify "flexing webs" or any other kind of webs. It calls for "skirt carriers." That is, any kind of a carrier, whether an independent web as shown by Jardine, or mere extension of the continuous skirt without any distinctive web, as shown by Hartog,—or posts,

[6] "Embrace" is a word of *broader scope,* employing inclusion; it does not appropriately indicate a limitation.

arms, or ribs shown by the other interferants. Nor is it true that the cancelled claim calls for webs "supporting retracted bosses," or any other kind of bosses. If we interpret by an application to Hartog, the skirt carriers were connected to the pressure receiving end by springing from a flange or rib depending from the head, and this flange or rib (not the skirt carriers) supported the bosses (see Fig. 1, p. 727); while, if we are not taught by the Hartog comparison, the phrase "skirt carriers connecting said webs to the pressure receiving end" is of the broadest possible character as to this element, and seems to cover any conceivable form of supporting connection (as in Long and Spillman).

We further notice that "retracted bosses" are not, under any nomenclature, a feature of the cancelled claim, and are not a feature of the allowed claim,—when the distinction is observed between retracted bosses and skirt retraction pointed out above (p. 7). The court below, in its opinion upon the Jardine patent, recognized that while Jardine had the general conception formerly attributed to Gulick he had it "with modifications which may improve but do not destroy it." One of these modifications which did improve Gulick was the substitution of the non-continuance or "retraction" of the skirt over the region of the bosses, thereby uncovering the web and the bosses, which feature Gulick *did not have* and Hartog (Long and Spillman) *did not have* and the cancelled claim *did not have* but the allowed claim *did have*.

It is of course true that neither amended nor allowed claims specified in words, as an element, the resulting balanced skirt flexibility, which in fact did exist in, and which was due to the cooperation of the parts in, the *allowed* claim, but did not exist by the cooperation of the parts specified in the *cancelled* claim (properly interpreted by its application to Hartog (Long and Spillman)). The court below pointed out that the operation of Hartog could not be

well ascertained from specification and drawing (R. p. 924); and at any rate there is no testimony that the cooperation of the parts named in the cancelled claim would or could produce the result which did follow from the cooperation of the parts of the allowed claim,—the vital minute clearance. Hartog neither had nor solved any problem of thermal expansion, and hence the amended claim, applicable to and met by Hartog, gave no solution by a "flexibility" "balanced" to meet that problem. Hartog presented only a skirt having *tensional* flexibility, having the functions of, and proposed as a substitute for, the ordinary packing rings (See R. p. 729, 2nd col.). The cancelled claim therefore embraced even a resilient spring tensional flexibility.

With still further reference to the same paragraph, it is not seen how one can be aided in determining the identity of two claims by observing that both of them omit certain features. Both of these claims might have been extended by including a number of other cooperating elements like the cylinder and the piston pin and the connecting rod, but such common omission of a subtrahend does not tend to prove the identity of the two remainders. Such a conclusion is a *non sequitur*; the witnesses who did not see an act usually outnumber those who did.

The only other portion of the opinion in which the Court compared the abandoned and the allowed claims is in the first full paragraph of page 7. In stating the similarity, it said "both are combination claims" for a piston having a head and a skirt "connected with the head by ribs, webs or skirt carriers." This statement might seem to infer that the phrase "ribs, webs or skirt carriers" appeared in both claims, but of course it is not so intended. The connecting means is described by Jardine's specification and allowed claim 8 as "webs." Such means is described in claims 20E, 21E and 22E in apparently the broadest possible terms as "joining means" which are "resiliently yieldable." It is

described in claim 16E, in language of a bit less breadth, as "internal yielding ribs." It is described in 18E as "downwardly extending resilient arms." In 19E it is described as "skirt carriers * * * susceptible of being slightly flexed radially." The declarations of interference assumed that Jardine's "web" was one specific kind of the "yielding means," etc., of the (Long, Spillman or) Hartog claims; they did not assume that all "yielding means" of all these other forms, were "webs." No one of these cancelled claims calls for a "web," flexible or non-flexible. A web as described by Jardine is a flat, thin plate of metal extending, approximately at right angles to, and in opposite directions from, its supporting pier or member, out to the skirt, and, with its complementary web on the other side of the piston pin, bearing a double chordal relation to the skirt circumference. This term, thus defined, applied accurately to Jardine. It is clear that all of the other applicants who were put into interference, and whose claims Jardine copied as a required preliminary to the interference, were attempting to get a monopoly in this respect in some much broader terms,—*all* "yielding ribs," *all* "resilient arms," *all* "carriers slightly flexible." That these many claims were put into interference, while Jardine's then existing allowed claims calling for webs (R. pp. 756, 769, 774) were not put into interference, is demonstration, if demonstration were necessary, that the Patent Office regarded webs as one thing, with one distinct and limited meaning, and regarded "yielding means," "yielding ribs," etc., as broader and, therefore, different descriptions for the connecting means and therefore as expressing different things. In short, the Patent Office proposed these various expressions in these various claims as marking differentiation from the webs found in Jardine's then existing allowed claims not put into interference and in his ultimately allowed claims; all parties acquiesced in the Patent Office finding that these words marked and *declared differentiation* between the claims;

but now the Court finds that these differing words mark and *declare identity* between the claims.

Coming now to the second paragraph on page 7, the opinion says that Jardine did not, during his correspondence with the Patent Office of his application, "urge that he was the inventor of a piston having flexible webs." True enough, so far as express words go; but why should he? He had most elaborately described and shown in his specification that his invention did pertain to a flexible web, and had particularly described different forms in which it might bend. He was making claims which involved as elements the webs which he had described, and he was presumed to know, as this Court has decided might be assumed to be the law, that his claim would be interpreted as limited to the web described or its substantial equivalent. The rightful negative inference to be drawn from the prosecution of his application is that Jardine "did not at any time in file wrapper letters urge that he was the inventor of *all and every* flexible means for joining head and skirt section." During the interferences on these broad claims, he contended that he was such broad inventor, after the decision against him, he did not.

The opinion in this same paragraph says also that Jardine urged as his only advance over Ricardo the addition of a slotted skirt "which changes the structure and the resistance to a disposal of the forces within and without the piston when the piston is in use." Yes; but in the next sentence (R. p. 775) Jardine urges that "pressures operating on the piston will operate in different directions and must be met and handled in such a way as to realize the advantages sought for." As interpreted by the specification, this "urging" by Jardine meant that the pressures operating in different directions would create a tendency to close the slot, which tendency was accommodated by the bending of the webs, and that the stated flexibility of the

webs permitted the conflicting expanding and compressive forces to be "met and handled in such a way as to realize the advantages" described in the specification. That is our position today.

It is true, as further stated in this same paragraph of the opinion, and as was the custom in the Patent Office, that after the interferences were terminated, the applicant revised and rewrote his claims in the light of the interferences and their result. Jardine then knew that he must confine his claims to the webs which he had shown and described; and he did so. Claim 1 as issued (then 8, R. p. 769) stood allowed (R. p. 774) and, in submitting this final amendment, Jardine had no occasion to comment on claim 1. It has been sustained by the court below, and it is sufficient to support that court's decree. In his comment Jardine did say as to issued claim 8 (then 28, R. p. 839) that it was "similar to claim 3 but recites in addition that the webs are integral with the ring flange." This reference to the integrality of the webs with the flange was not to distinguish from the interference issue or the prior art or to characterize the invention of this claim, but to distinguish from the then allowed claim 3. The comment on issued claim 11 (then claim 31) not only refers to the webs as the opinion says it does, but goes on to specify that the webs "have substantially all of their outer sides exposed."[7] Throughout these final comments Jardine assumes, as was the fact, that he and the Patent Office were in accord as to the invention to which he was entitled, and he was only pointing out the distinction between his various claims to show that there was no duplication.

Coming back to the paragraph on page 9 of the opinion, it concludes with the statement that the only difference between the amended and the allowed claims is that the

[7] In substantial distinction from every one of the cancelled claims which touched "flexibility."

former contained, while the latter did not, a specification of the flexible web feature. We have already pointed out that amended claim 19E was like the other amended claims in that no one of them pointed out or referred to the "flexible web" feature. No one of them, in attributing to some feature the ultimate character of the combination when operating under conditions of expansion and compression, attributed this characteristic to a "web," as that element was described in the Jardine specification, which had adopted this nomenclature. Each of these claims used a much broader term, which was generic enough to include webs and many other forms. In some possibly generic sense the webs of the allowed claim were "yielding ribs," "resilient arms," "joining means resiliently yieldable" or "means for yieldingly connecting the said skirt section with the head"; but that these generic terms should be considered as completely co-extensive with and therefore equivalent to the specific form of "yielding means" which Jardine had described and distinctively denominated a "web" is, we respectfully insist, a view of claim equivalency which has no precedent in the decisions of the Patent Office or of the courts.

II. Claim Breadth and Construction.

By the settled rule of familiar application, the cancellation of broader claims prevents giving to an issued narrower claim a construction which will make it equivalent to the cancelled claim, as the court says on page 8 of the opinion. To make the principle of this rule applicable to the present case, the court thought it necessary to declare, or assume, that the claims abandoned were narrower, and the claims allowed were respectively broader; and this assumption plainly lies at the base of the court's reasoning, and unless it is sound, the result reached by the opinion is not defensible.

This involves the broad question of the accepted patent office definition of these terms, "narrow" and "broad,"—by which definition all parties are bound, since that definition and understanding must have characterized the action of the patent office and the parties in making, as well as in cancelling, claims. As is pointed out in the pedagogical and very elementary discussion in *Scaife v. Fall City*, 209 Fed. 210, to which the court referred in its opinion, there can be no inevitable and definite differentiation by using these terms. Oftentimes the distinction is clear. Sometimes it cannot be clearly made. The most common criterion is found in the number of elements, or the omission or inclusion of an element; but more frequently it may be found in the broader or the narrower specification of the same element found in both claims. For the purpose of this conclusion no careful comparison can be made unless the claims, which finally speak as a composite whole, are analyzed into their elements and then compared.[8] In making this comparison, and to get the same point of view held by the court, we must necessarily assume that the "web" of the allowed claim was the flexible web which it becomes by plaintiffs' construction. Therefore, we occasionally insert in parentheses the word "flexible."

Specifying these elements in the allowed claim 8 we find:

1. A head
    (1-a) Having a cylindrical flange,
        (1-a-x) for the piston rings.
2. Webs
    (2-a) (flexible)
    (2-b) Oppositely disposed.
    (2-c) *Integral with the flange.*
    (2-d) *Carrying the piston pin bosses.*

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[8] Such a comparison is necessarily tedious and we hesitate so to tax the patience of the Ccurt; but, if given careful thought, it will determine whether the opinion of the court in this respect was right or wrong.

3. A skirt
   - (3-a) Integral with the webs.
   - (3-b) *Cut away over the webs* (and therefore over the bosses).

4. Circumferential slits
   - (4-a) Between the ring flange and the skirt.

5. A longitudinal slit
   - (5-a) *Between the ends of the webs.*

6. Bosses, carried by the webs.

Now comparing this with the cancelled claim 19E (and indicating such similarity as there is by the same number) we find:

1. A head
   - (1-a) Of cuplike form comprising a pressure receiving end and a wall portion.

2. No such element, but there are "skirt carriers," which do not meet (2c) and (2d) above, and which are distinctly defined as
   - (a) Connecting the skirt to the head.
   - (b) Slightly flexible
   - (b-x) radially.

3. A skirt,—which does not meet (3b) above, and which is distinctively defined by qualifications hereafter pointed out.

4. The corresponding element is tied to and modified by a different "disconnection"—see (3x) *infra*, p. 21.

5. No corresponding element.

6. No corresponding element.

Now comparing these, element for element:

(1) *Head and head.*—The mere limitations as to form, differently expressed, may not indicate any substantial difference (though, interpreted by their respective sources such difference might develop); but the ring flange, specified by the allowed claim, was the flange for carrying the

usual packing rings (p. 1 Jardine patent, lines 52, 53), while Hartog (and Long and Spillman), which, because the Patent Office applied 19E to it, must serve as the lexicon of 19E, has no packing rings at all, and therefore no ring flange. The Patent Office declared the difference, awarding to Jardine by the allowed claim the head which, while generally "cup shape," was limited to the form having grooves for rings, and gave to Hartog by 19E the broader form, in that the "ring" limitation was omitted. In this respect the cancelled claim was broader. The Patent Office thought the difference was substantial. There is no evidence that it was not substantial, and the court cannot judicially know.

(2) *Webs and skirt carriers.*—The differences are obvious. The web of the allowed claim was Jardine's form of the device which carried the bosses which in turn carried the skirt sections; the "skirt carriers" of the cancelled claim referred in a much broader way to any structure which performed this carrying function and, particularly, must have been intended to extend to and cover (Long and Spillman as well as) the Hartog structure,—an anomalous form which neither Hartog nor the Patent Office, nor anybody else ever called a web, but which can be well described only by the broad functional term "skirt carrier." Here again the cancelled claim is broader, the Patent Office thought the distinction material, and there is no evidence to justify holding it immaterial.

Another difference is this,—the allowed claim requires that the webs shall be integral with the ring flange and, therefore, integral with the head. The cancelled claim contains no such limitation as to the structure of the "skirt carriers," but only that they shall be in some way,—in any way,—*connected* to the head; and in fact, interpreted by an application to Hartog (as well as Long and Spillman) they are connected to and carried by differing forms, Hartog's being a vertical rib depending from near the center of the head. (Fig. 1, R. p. 727.) Obviously in this respect

the cancelled claim is broader than the one allowed. The record does not show, and the court cannot know, that this difference is, in operation, of no consequence. In fact these connections have also the function of heat transference and dissipation.

There is yet another difference. By the allowed claim it is required that the bosses shall be carried by this (flexible) web. By the old trunk style, the bosses were carried by the skirt itself. The method of carrying specified in the allowed claim permits the bosses in their axial expansion to take the benefit of this flexibility. In the cancelled claim there is no limitation as to how the bosses are to be carried. In fact the bosses are not mentioned at all, and if, in spite of this omission, the claim can be made over into an operative combination by implying that there must be some bosses somewhere, there is certainly no limitation as to how or where they should be carried. Again interpreting by an application to Hartog (and Long and Spillman) the cancelled claim contemplates differing forms, Hartog's being a rib or arm descending from the center of the head, which apparently rigid arm carries the bosses, and also supports Hartog's skirt carriers. Again it is clear that the cancelled claim is in this respect broader than the allowed claim, and the record does not show, and the court cannot know, that this difference was inconsequential under operating conditions.

There is a still further difference that, in the allowed claim, the contemplated flexing of the webs is tangential or chordal of the skirt sections and contemplates circumferential adjustment of the skirt sections, while in the cancelled claim the contemplated carrier flexibility extends to that which is radial of the skirt permitting radial adjustment of the skirt itself. Which of the two claims is broader in this respect it is impossible to say. Each is limited to a distinct type of flexibility; but we cannot presume,—and there is no evidence to show,—that the distinction meant nothing.

(3) *Skirt and skirt.*—The first difference is that by the allowed claim the skirt must be integral with the webs and therefore with the head (ring flange), thus receiving from the head the heat which expands the skirt, while by the cancelled claim there need be only some or any kind of connection. Evidently the cancelled claim is broader in this respect. The Patent Office thought this difference material, there is no evidence to the contrary, and we cannot presume the contrary.

The next difference is that in the allowed claim it is specified that the skirt must be retracted from or cut away over the bosses; in the cancelled claim there is no such restriction, and it cannot be implied, for then it would not read upon Hartog, and (as we believe) the other interferants to whom the Patent Office applied it by declaring the interference.[9] The importance of this distinction is pointed out *supra*, pp. 7-8. The cancelled claim is obviously broader in this respect.

The remaining differences which exist between the particular skirt of the allowed claim and the contemplated skirt of the cancelled claim are developed from the cancelled claims skirt limitations found in the following items (3x) and (3y).

(3x) The allowed claim calls for two circumferential slits, each one separating the ring flange (head) from the adjacent skirt section; the cancelled claim also calls for any kind of "disconnection," however wide or of whatever shape, between the skirt *carrier* (web?) and the wall portion of the *head*. These are different constructions, and the "slit" and this second "disconnection" are in different locations, with different uses. Whatever the proper interpretation of these different phrases may be, the language of the cancelled claim would cover a variety of possible con-

[9] The forms of Long and Spillman are not shown by the present record, as discussed in the motion filed herewith; but the impossibility of reading it upon Hartog is test enough.

structions, "disconnections," which would not be reached by the language of the allowed claim, "slits." The record does not show, and the court cannot know, that this difference would be insubstantial in operation.

(3y) The allowed claim specifies that the longitudinal slit in the skirt shall be *between the ends of the webs.* Applying this language to the Jardine construction, the ends of the webs are clearly the outer ends where they join the skirt sections and the slit therefore must be in that part of the skirt opposite the piston pin and at right angles thereto,—the horizontal sides on Figures 4, 5, 8 and 9 of Jardine; the cancelled claim calls only for any kind of "division of the skirt from end to end." The substantial, and indeed vital, distinction is that the longitudinal or vertical slot thus located in the allowed claim is thereby put in or near the center of the thrust face of the piston; while the "end to end (vertical) division" of the cancelled claim may be *anywhere* in the skirt circumference, and therefore it need not be in the center of the thrust face or in the thrust face at all. In fact, interpreting the cancelled claim again by its application to Hartog, its language was intended to refer to the space, if there was any after insertion in the cylinder, between the extreme edge of one skirt section, remote from its carrier, and the radial end of the carrier of the other section, and this division was not in the thrust face at all.[10] It happens to be familiar to counsel upon both sides, through development in other litigation, and indeed it appears from the record in this case regarding Maynard, that this slot, to be most useful, should be in the center of the thrust face, and that when much removed therefrom it ceases to be relatively useful, or useful at all; but at any rate there is no testimony showing that this difference in the location of the slot is insubstantial

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[10] The thrust face of Hartog, looking at Figure 4, is that portion on and immediately adjacent to a horizontal line through the center of the figure. (R. p. 727.)

in operation, and the court cannot say that it is. Obviously, also, the broad language of the cancelled claim,—a vertical "division" located anywhere in the circumference,—is much broader in this respect than the allowed claim, which located the slot at that particular point in the circumference where only it becomes useful.

If now we leave the specific comparison and turn to the comment of the court on page 9 which said that the "retraction of the skirt from the bosses" and "balanced skirt flexibility" could be construed into the cancelled claim by reference to specifications and drawings, we see by reference to *Spillman and Long,* whose constructions appear by our accompanying motion, that these two elements are not disclosed by Spillman or Long so that to read these limitations into claim 19E would be to give this claim an interpretation not given to it by the Patent Office, by Jardine, or by any other party to the interference when it was suggested, made, prosecuted or cancelled. It was the claim without these limitations in it that was abandoned and cancelled. Hence, when the court in effect said that it was the claim as thus limited which was cancelled, it is quite clear that the statement could not have been correct. If the cancelled claim by virtue of any proceedings of the Patent Office and the acquiescence of the parties therein was to be given any construction except the one apparent on its face, it was the duty of the defendant to show such Patent Office construction. The defendant did not do this and thereby misled the court. In fact the Patent Office proceedings in this record, and additionally, when supplemented by our motion, show the contrary.

In summary: Whether this comparison is made carefully and in detail as above set out, or whether it is made more broadly by observing only what are perhaps the most outstanding differences,—(1) the absence from the cancelled claim of any reference to the bosses, and much less of any limitation as to where and how they should be carried,

(2) the absence from the cancelled claim of the limitation that the skirt shall not extend over the region of the bosses, (3) the flat contradiction between the allowed claim limitation that the web (skirt carrier) shall be "*integral with*" the ring flange (wall portion of the head) and the cancelled claim limitation that the skirt carrier (web) shall be "*disconnected from*" the wall portion of the head (ring flange), and (4) the absence from the cancelled claim of any limitation that the longitudinal slot shall be in the thrust face,—in either case we earnestly submit that it is quite as impossible to say that the allowed claim and the cancelled claim are (except for web flexibility) substantially equivalent, as it is impossible to say that the former is broader than the latter.

It is an inflexible rule in the Patent Office that a count to an interference will be given the broadest construction that its language will bear.

This rule is stated by the Court of Appeals of the District of Columbia in *Hewlett v. Steinberger*, 1913 Commissioner's Decisions, page 372, as follows:

> "We fully agree with the finding of the Commissioner that the corrugations of Steinberger, being properly positioned, perform and were intended to perform substantially the same function of the so-called 'flanges' and 'collars' of the issue. The terms are therefore synonymous, as used in this record. *This conclusion recognizes the rule that claims should be given the broadest interpretation consistent with the terms.* (*Lindmark v. Hodgkinson*, C. D., 1908, 540; 137 O. G., 223; 31 App. D. C., 612; *Viele v. Cummings*, C. D., 1908, 362; 134 O. G., 777; 30 App. D. C., 455; *Miel v. Young*, C. D., 1907, 561; 128 O. G., 2532; 29 App. D. C., 481.)" (Emphasis ours.)

The rule has been followed for years, was followed during the Jardine interferences, and is still followed.

This rule was applied in interpreting claim 18 (19E) in the Patent Office and, of course, under this interpretation did not include features (a) "retraction of the skirt from the bosses" and (b) "balanced skirt flexibility." When this Court construed features (a) and (b) into claim 18 (19E) it made something that had not been before the Patent Office, had not been in the Jardine application, had not been made by Jardine and had not been cancelled or abandoned by Jardine.

III. The Converse Estoppel.

On page 8 of the opinion the court expresses wonder, as did the court in the *Morgan Envelope* case, why the Patent Office allowed the broad claim after rejecting the narrower one. This wonder is not strange. The short answer is that the Patent Office did not do so, either in this case or in the *Morgan Envelope* case.

It is conceivable that the Patent Office would grant a broad claim and refuse a narrow one in the same application because it thought the narrow one involved no inventive improvement or distinction over the generic claim; but that did not happen in this case nor in the *Morgan Envelope* case. Jardine had devised one specific form, and Hartog (as well as each other interferant) had devised another specific form, all of which forms the Patent Office thought could be included within some generic phrase. If so, it was elementary that the generic claim should go to the first inventor while the later inventor could have only the specific form. Accordingly and resulting from this underlying rule, the interference was declared, to see who was the first inventor. Although the dates were close, it was decided that Hartog was first (as between him and Jardine) and so he became part of the prior art as against Jardine. This decision made it imperative that Hartog should have the broad claim and Jardine the narrow one. One who invents a specific form, generically new, thereby

becomes and is entitled to a generic claim,—even though at the time he may not know it. The Patent Office tribunals could not be more shocked than to be told that they had decided the issue of priority in favor of Hartog, and had awarded the broad claim to Jardine.

This consideration only confirms the conclusion which has already been necessarily reached by comparison of the allowed with the cancelled claims.

Whether the rule as to the estoppel coming from abandoning a broad and accepting a narrower claim can rightly be always extended to the converse situation, is an interesting legal question which does not seem to us now controlling. However, in Appendix B we consider the *dictum* found in the *Morgan Envelope* case and whether it should be adopted and followed.

The other cases cited in the second paragraph of page 8, do not support this "converse" proposition. In no one of them is it involved, discussed or decided.

IV. Claims as a Composite Unit.

The opinion in the last paragraph on page 8 takes note of our insistence that when claims are to be compared to develop similarity or differences we must compare not the relative modifications of specific elements, but the combination as a whole as a composite unit; and, while perhaps assuming this general rule to be correct the opinion proceeds to treat the summary comment of the court below in its opinion as though that court had intended to rewrite the claim, and then this Court considers this summary comment as though it were the claim in suit. The court below had no intention to rewrite the claim. It said (R. p. 924) that its conclusion of the validity of the claims sued upon

> "is based upon the concept of a combination with balanced skirt flexibility due to cooperation of longitud-

inal[11] [circumferential] and vertical slotting with flexing webs supporting retracted bosses and connected to a skirt thereby made responsive to physical pressure and thermal expansion so as to permit of minute clearances between piston and cylinder."

Clearly, that court was not intending to modify or disparage any of the elements of the claim in suit; it was stating operation and results. A claim in this language would have been promptly rejected by the Patent Office as being functional,—such claims are not permitted.

It is not conceivable that an experienced court, thus stating the operation and result of a combination claim, due to the coaction of elements which it recites in general terms, would intend to say that there would be the suggested cooperation between *any kind* of longitudinal [circumferential] slotting wherever it might happen to be located and whether operative or not, and *any kind* of vertical slotting wherever located and whether operative or not, or *any kind* of flexing webs whatever the shape or location, or *any kind* of retracted bosses no matter how carried and how operating, or *any kind* of a skirt however complete or however sectional.[12] The court most certainly had reference to the circumferential slotting described and shown by Jardine, and to vertical slotting operating as described and shown by Jardine, and to flexing webs operating as described and shown by Jardine, and to bosses retracted and supported and operating as shown by Jardine, and to a skirt cut away so as to operate as shown by Jardine and which was connected to the bosses with the effect described and shown by Jardine. The concept thus stated by the court was such as brought the final result,—permitting the minute essential clearances between piston and cyl-

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[11] Through some typographic or clerical error at some stage in the proceeding this word "longitudinal" has been accidentally substituted for "circumferential."

[12] To use Justice Holmes' familiar phrase, that court was not speaking "*in vacuo.*"

inder. There is no evidence to the effect that, and the court below could not presume, and this Court cannot presume, that this result of minute clearances could be brought about by using any other type[13] of circumferential slotting or any other type of vertical slotting or any other type of flexing means or any bosses otherwise connected or supported, or any other type of skirt, or any other type of connections, than those operating as described by Jardine, and every one of which is embodied by appropriate limitations (express or implied) in the allowed claims upon which suit is brought. If the skirt were not cut away from the bosses to permit unrestricted boss axial expansion, or if the bosses were not carried by the flexible webs so as to cooperate in this expansion, or if the webs were not integrally connected to the ring flange so as to permit the contemplated heat conduction, or if the vertical slot were not located in the thrust face,—all as the allowed claim specifies and as the cancelled claim does not,—the first result, "balanced skirt flexibility" and the ultimate result, "minute clearance," would not be achieved,—at least, there is no evidence whatever that they would be, and the verdict of the industry is to the contrary.

The result is, as we respectfully submit, that instead of giving due effect to the rule that identity or difference in claims depends upon consideration of the complete claims, as composite units, rather than upon this or that difference between the respective details of corresponding elements, the court has rewritten Jardine's cancelled claims (*e.g.*, 19E) so as to narrow them to include specific unnamed limitations, and having so rewritten them to make them narrower and more specific, the court then finds them equivalent to the similarly specific claims which Jardine retained and which were allowed. *Of course,*—no reasonably specific claim could survive such method of treatment.

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[13] By "type" we mean the form shown and such equivalency as the specification and the state of the art indicated including the accused piston Ex. 1.

The statement in a rehearing application, that the opinion of the court will have a revolutionary effect upon some rule of law or some established procedure, is probably so familiar to this Court as to be trite; yet we must urge that for this Court to say that claims 8 and 19E are equivalent (except for web flexibility), or to say that 8 is broader than 19E, is to disregard and thus invalidate the theories of claim distinction and claim breadth that have prevailed in the Patent Office and in the patent courts longer than any of us can remember. The court surely did not intend to do that.

V. Other Errors in the Opinion.

We call attention to these, not because they are necessarily controlling but because we think the Court, on reflection, may wish to make some change.

1. In its former opinion the Court took as its text from which to discuss the Gulick patent, claim 39, which it quoted at length and to which it applied its reasoning. This was confusing, because claim 39 was not in suit and had never been considered, much less sustained, by the court below. In our subsequent memoranda suggesting changes, if not rehearing, we called attention to this error, but the Court made no response. Now, in the present opinion, in reciting the former proceedings, the Court repeats this same error.

2. On page 6 of the opinion, after reciting claim 8, the court says "claims 5 and 6 refer to the 'skirt portion cut away from the head to expose the bosses.'" The first thought would be that the court intended to refer to the two other claims which were in suit, 1 and 11, in which case the reference is accurate and effective. If it were possibly intended only to emphasize the persistence in the claims of this limitation, a complete statement would have been that it is found in each of the twelve issued claims except No. 10, either in these express words, or by saying that the skirt merges into the webs,—so that it could not separately continue overlying the webs.

3. The recital in the last paragraph of page 3 would seem to the casual reader to import that the court below, after it had held the Jardine patent invalid and directed the bill to be dismissed, found in the first opinion of this Court occasion or excuse for recalling its mandate and reaching a contrary result. Doubtless this Court did not intend its recital to be so construed or to imply any disparagement; but a complete recital would have left no room for misunderstanding. It would have shown that on the first hearing the court below sustained the Gulick and Maynard patents and, as to the Jardine patent, declined to pass upon its validity or infringement, because those subjects had become immaterial after the broader patents were sustained, and so it ordered that the District Court should dismiss the bill as to Jardine *without prejudice*; that it withheld its mandate pending certiorari proceedings in this Court; that in February, 1938 this Court denied defendants' petition for certiorari; that in March, 1938 this Court denied defendants' request for rehearing of such petition; that this result was certified to the court below and thereupon. in March, 1938 that court issued its mandate to the District Court directing the dismissal of Jardine *without prejudice,* because that patent had not been considered; that the decree of the District Court was entered accordingly pursuant to this mandate; that in June, 1938 this Court granted the defendants' petition for leave to file a second petition for rehearing and granted the rehearing and granted the writ,—although no reason was advanced by petitioner except those which (though in other words) had been twice before presented and overruled; that upon the hearing this Court expressly directed the court below to reconsider the Jardine patent and pass upon its validity; that the court below expressly followed the

direction of this Court and recalled its mandate only because the order of this Court had made that recall necessary.

All of which is respectfully submitted.

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January 3, 1941.

We hereby certify that the foregoing petition for rehearing is presented in good faith and not for delay.

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APPENDIX A.

HISTORY OF THE PETITIONERS' (DEFENDANTS') ATTACKS UPON THE JARDINE PATENT, AS COMPARED WITH THE BASIC PROPOSITIONS OF THE COURT'S OPINION.

So far as we can find, the two propositions stated, *supra*, p. 3, never were raised at any time by defendant. The suggestion, or the contention, that the Jardine claims in suit, 1, 8 and 11, ought not to be construed in the normal way, by the specification, but rather by comparison with abandoned and cancelled claims, was never made before the Master nor mentioned by him in his elaborate report. It was not made in the briefs and arguments before the District Judge, nor mentioned by him in his memorandum. It was not made by defendants' briefs before the Circuit Court of Appeals in the first hearing nor mentioned by that court in its first opinion. It was not made in the defendants' first brief before the Court of Appeals upon the second hearing. It was first made in defendants' supplemental brief upon the second hearing, summarized in a five line paragraph quoted in the margin,* and which plainly assumed that because broad claims had been lost by interference, the allowed claims could not be given the broad construction plaintiff claimed; it raised a question of infringement, not of validity. This brief then, in its references to the "relief" or the "skirt retraction" found in claims 1, 8 and 11, takes for granted the materiality of this differentiation between the allowed and the abandoned, but contends only that it did not distinguish from the prior Long public use. There was no suggestion that it did not materially distinguish from the Hartog construction, which was one of the forms covered in amended claim 19E (or Spillman and Long). The brief then says (p. 53) that be-

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* "2. Jardine lost in interferences with both Long and Hartog, and therefore cannot claim any construction, either by application of the rule of equivalents or otherwise, sufficiently broad to cover any of the pistons before this court." (p. 44.)

cause "web flexibility" had been conceded to Long and Hartog in the interferences, the claims in suit must be narrowly construed as restricted to details which were non-inventive or not infringed.

To this the present respondents (then plaintiffs) replied (p. 16 Reply to Supp. Br.) that file wrapper estoppel did not extend to invalidate claims which had been allowed because they differed from claims which had been rejected; that these rejected claims had been rejected on prior art and were cancelled; that the claims now in the patent and sued upon were allowed because they differed from the prior art, while the cancelled claims did not so differ; and concluded "we do not here seek a construction of the patented claims co-extensive with the rejected and cancelled claims."

Since it had not been even suggested to the Court of Appeals upon the second hearing that the claims sued upon (with plaintiffs' construction) were substantially identical with cancelled claims, and since the rule, that the cancellation of a broader claim did not prevent giving the proper interpretation to the retained and allowed narrower claim, covered the situation so obviously and completely, the Court of Appeals very naturally did not mention the subject in its second opinion.

In the (then) defendants' petition for rehearing, the subject was not mentioned. In the petition for certiorari and the accompanying brief, it was contended (pp. 4 and 5) that because Jardine had surrendered the claims which were in the interferences and which (it is erroneously said) "included flexing webs," the claims in suit could not be interpreted by the specification to call for flexing webs. Nowhere in the original petition and brief or in the petitioners' main brief in this Court was it said that the allowed claims were substantially equivalent to the cancelled claims (except for web flexibility); but the defendants' contention was that because in some abandoned claim, though generally

very much broader than and plainly nonequivalent to the allowed claim, there had been mention of a particular quality (flexibility), that particular quality could not thereafter be regarded as characteristic of an element in the allowed combination claim, even though the specification so directed.

Since petitioners' brief had not alleged substantial identity (except for web flexibility) between rejected claims and allowed claims, and had not contended that the allowed claims, as claims, were broader than those cancelled, our brief did not discuss either idea, but insisted (p. 44) that the claims which were abandoned were much broader than those allowed (as indeed petitioners had admitted) and, therefore, the abandonment of the broader claim did not prevent the proper construction of the allowed narrower claim; and petitioners' reply brief did not suggest that the claims allowed were, as combinations, broader than the abandoned claims, nor set up any specific comparison to support the contention that the claims abandoned and the claims allowed were (except for web flexibility) substantially identical.

Our recollection of the oral argument is that we pointed out that the claims lost in interference were much broader than the claims allowed and, therefore, could not result in forbidding any reasonable specific construction of the claim allowed, while petitioners urged only that the inclusion in the abandoned claim of one limiting adjectival word in describing one element, no matter what the remainder of the claim was or how broad it was, prevented considering that element in the different allowed claim as properly subject to the same limitation, though that limitation would otherwise be properly implied from the specification.

From this review it appears that we are justified in the statement on p. 3 that we have never had the proper opportunity and occasion to be heard upon these two propositions.

APPENDIX B.

THE MORGAN ENVELOPE CASE.

On page 8 of the opinion this Court refers to *Morgan Envelope Co. v. Albany Paper Co.*, 152 U. S., 425, 429. The Supreme Court, after stating the general proposition that one who has abandoned the broader claim and accepted a narrower cannot thereafter extend the narrower by construction so as to be equivalent to the broader, added "that the principle is the same if the rejected claim be narrower." We are here concerned only with this later and corollary conclusion, upon which this Court now rests its opinion. Examination of the *Morgan Envelope* case makes clear that this corollary was a *dictum* not called for by, nor based upon, the facts of the case. The article involved was a roll of toilet paper. It was made upon the forming roll which so became its interior diameter, and its outer diameter was determined by the thickness of the paper in its windings. The original claim called for a roll of oval form and made no mention of any limiting relationship between interior and exterior diameters. This claim was rejected upon reference to some earlier oval forms. Applicant then substituted a claim specifying that the interior diameter should be greater than the thickness of the paper roll, that is, less than the difference between the interior and external diameters. Obviously, when this limitation was applied to rolls of oval form, the amended claim was narrower than the original. On the other hand, the amended claim would cover rolls other than those of oval form, and thus in this respect was broader. The action of the Patent Office in allowing and issuing the amended claim was a finding that the invention consisted not in the form of the roll, but in the difference between interior and external diameters, and that by the amended claim the patent was limited to the true invention instead of extending beyond that to all rolls of oval form no matter what the thickness of the paper. Justice Brown therefore was wrong in considering the amended

claim to be broader, and the statement of what the law would be in such case thereupon became a *dictum*.

It is not seen how a case can ever arise where the facts call for the application of the supposed converse rule; but Justice Brown's statement that "the principle is the same" was not well considered. The principle is not the same and the same conclusion is not indicated. When a patentee acquiesces in the rejection of his broad claim, he thereby abandons and dedicates to the public a portion of his originally claimed monopoly. He says to the public, represented by the Patent Office, "If you will give me a part, I will not claim the whole." The Patent Office acts on this representation, and after such action he may not prejudicially withdraw or deny the representation. Thus the principle of estoppel plainly applies. In the converse case, the patentee says to the Patent Office, "Since you are granting me a monopoly of the whole, I do not choose to insist upon a separate grant to a specific form which is a part of the whole." The grant of the whole, the generic claim, does not in any degree depend upon the abandonment of a part, the specific claim. In granting the broad claim the Patent Office action is not based upon the withdrawal of the specific. There is no estoppel.

According to Shepherd's Citations, with reference to the first paragraph of the syllabus, the *Morgan Envelope* case has been cited some seventy times in the Supreme Court Reports and the Federal Reporter. All these citations have been examined,—carefully, we believe, and in all but one the citation had reference to the main rule. No reference whatever to the converse situation is found excepting in one case (*Thomas v. Rocker*, 77 Fed., 420, 431) and in that one the court, after casual approval, held that the abandoned claim had been the broader one, and applied the general rule.

If this dictum of Justice Brown is a fallacy (as in its universality it surely is) it is unfortunate that after nearly fifty years of "innocuous desuetude," it should now be resurrected, and authoritatively pronounced.

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